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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,889	09/09/2003	Arthur A. Tartaglia	DERZ 2 00001	2637
7590	05/17/2005		EXAMINER	
Scott A. McCollister Fay, Sharpe, Fagan, Minnich & McKee, LLP Seventh Floor 1100 Superior Avenue Cleveland, OH 44114-2579			ROANE, AARON F	
			ART UNIT	PAPER NUMBER
			3739	
DATE MAILED: 05/17/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/657,889	TARTAGLIA, ARTHUR A.
	Examiner Aaron Roane	Art Unit 3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 25 February 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-10 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Salisbury et al. (USPN 5,435,245).

Regarding claims 1, 2 and 7, Salisbury et al. disclose a marking pen comprising: a handle (collectively 22,26 and 24) having a first end (located adjacent 32) and a second end (the end located away from the wheel 16 and the crown 32); a wheel (16) rotably attached to the first end of said handle, said wheel comprising a polymer that absorbs ink, see col. 2-5 and figures 1-25. Although, Salisbury et al. are silent as to whether or not the device is, can be and/or is intended to be used for indicating the proper location of an incision to be made on a patient undergoing surgery, Salisbury et al. disclose a device that has all of the structural limitations of the claimed invention. The recitation that the marking pen is used for indicating the proper location of an incision to be made on a patient undergoing surgery is interpreted as intended use, a recitation of the intended use of the claimed

invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Salisbury et al. further disclose that the wheel comprises a flat or arcuate marking surface disposed at a peripheral edge of said wheel

Regarding claim 3, Salisbury et al. further disclose the wheel comprises a plurality of treads (20) disposed about the peripheral edge of said wheel, each, tread defining a marking surface, see figures 1-25.

Regarding claim 4, Salisbury et al. further disclose the marking surface is flat or arcuate, see figures 1-25.

Regarding claim 5, Salisbury et al. further the handle includes a removable neck (26 and its analogous counterparts in the other embodiments) disposed at the first end, the wheel being rotably attached to the removable neck, see col. 2-5 and figures 1-25.

Regarding claims 6 and 9, Salisbury et al. further the handle includes a bend (located at the interface of 22 and 26, and their counterparts in the other embodiments) to provide an ergonomically shaped handle, see col. 2-5 and figures 1-25.

Regarding claim 8, Salisbury et al. further the wheel comprises a material (material comprising 16 and 20) that can absorb ink and dispense ink onto a patient's skin, see col. 2-5 and figures 1-25.

Regarding claim 10, Salisbury et al. further wheel comprises polyethylene or polypropylene, see col. 4, lines 3-4.

Response to Arguments

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection. The examiner has provided new prior art to reject claims 1-10. Although the new prior art, Salisbury et al. (USPN 5,435,245) is not intended for indicating the proper location of an incision to be made on a patient undergoing surgery, it discloses all of the structural features claimed and therefore meets the claim.

Conclusion

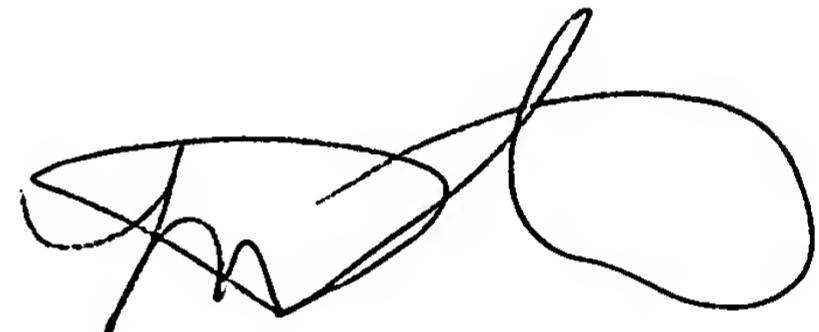
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

Art Unit: 3739

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.R. *A.R.*
May 10, 2005



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